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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,728	08/05/2003	David M. Chess	YOR920030230US1	8862

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EXAMINER	
CHOULES, JACK M	

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/635,728	CHESS ET AL.	
	Examiner	Art Unit	
	Jack M Choules	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-31 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-12, 18-28 and 30-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

4. Claims 1-12,18-19, and 30-31 are directed to "A performance prediction system" that is clearly a data structure Per Se and/or a computer listing Per Se. Thus being descriptive material Per Se and hence nonstatutory (see MPEP 2106 IV B 1 (a)).

> From MPEP 2106 IV B 1 (a). Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se
>
> Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

5. And claims 20-28 are directed to a corresponding "method to provide performance prediction information," performed on data structures Per Se and or computer listings Per Se.

The separate steps of the claims, for example receiving queries, are assumed to be preformed in software on data structures. The examiner finds no limitation in the claims to hardware or other physical structure and no limitation of the claims that is defined in the specification, as being physical structures as software and data is not considered a physical structure. See the PMEP section 2106 IV B 1 (a). The courts have held in In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), wherein claims to a data structure stored in memory were held to be statutory subject matter because of the statutory nature of the memory. However, as no memory or other physical structure is claimed in the claims recited Lowry does not control the examiners decision to reject. The "method to provide performance prediction information," is considered to be broad enough to include mental steps or manipulation of abstract ideas as no physical structure is claimed on which to apply the acts (see MPEP 2106 IV B 1).

> From MPEP 2106 IV B 1. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Schrader, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 13 and 31 are rejected under 35 U.S.C. 112, first paragraph, because of undue breadth in the claims as being single means claims.

8. As to claim 13, claiming the single means "a programmed data processor for" and the function for that means or using acquired knowledge of previously submitted queries..."

9. As to claim 31, claiming the single means "a communications interface adapted for" and two alternative functions for "submitting a meta-query to the service" or "receiving enhanced performance prediction information from the service"

MPEP § 2164.08(a) Single Means Claim
A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.
10.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 26 recites the limitation "the enhanced performance prediction information" in line 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, 2, 11-15, 18-22, and 25-31 are rejected under 35 U.S.C. 102(b) as being anticipate by Osborn et al. [hereinafter Osborn et al] US Patent No. 6,026,391.

16. As to claims 1, 13, 18, 20, 29, 30, and 31, Osborn et al. teaches a system comprising: "a query component for receiving queries submitted by users" (column 6, lines 1-22) "for data relevant to the probability that a transaction with an entity will be successful" (column 6, lines 23-50 and column 1, lines 43-62); "a data gathering component for storing relevant data about submitted queries" (column 6, line 51-67 and column 7, lines 1-16); and a meta-query component responsive to a meta-query for returning information regarding previously submitted queries" (column 7, lines 7-58). Using the text of claim 1, other claims rejected are considered to have similar element disclosed by the same prior art cited.

17. As to claims 2 and 19, Osborn et al. teaches a system further comprising: "a performance-prediction component that uses data comprising including the stored submitted query data in making estimations relevant to the likelihood of success of a transaction involving an entity will be successful" (column 7, lines 7-58 and column 1, lines 43-62). Using the text of

claim 2, other claims rejected are considered to have similar element disclosed by the same prior art cited.

18. As to claim 11, Osborn et al. teaches a system further comprising: "the performance prediction component determines statistical correlations between patterns of submitted queries (column 7, lines 17-35).

19. As to claims 12, 14, 15, 21, and 22, Osborn et al. teaches a system further comprising: "where the performance prediction component further uses one of actual and predicted performance of entities, and uses the statistical correlations to predict likely future performance based on past and present query data" (column 7, lines 7-35).

20. As to claim 25, Osborn et al. teaches a system further comprising: "collecting query-relevant data comprising at least one of time, date, location, and identity" (column 6, lines 51-64).

21. As to claim 26, Osborn et al. teaches a system further comprising: "filtering the enhanced performance prediction information to remove at least some of the collected query-relevant data" (column 7 lines 7-58) only estimated time returned therefore rest of data was filtered.

22. As to claim 27, Osborn et al. teaches a system further comprising: "further comprising registering for automatically querying the acquired Knowledge" (column 2 lines 1-23 and column 7, lines 7-35) incorporating the QPP is considered registering for automatically querying.

23. As to claim 28, Osborn et al. teaches a system further comprising: "where automatic querying is initiated upon the occurrence of at least one specified criterion" (column 2 lines 1-23 and column 7, lines 7-35) the specified criterion is receiving a query from the user.

24. **Claims 1, 2, 6-8, 11, 13, 18-20, 25, 26, and 29-31, are rejected under 35 U.S.C. 102(e) as being anticipate by Moore US Patent No. 6,847,938.**

25. As to claims 1, 13, 18, 20, 29, 30, and 31, Moore et al. teaches a system comprising: "a query component for receiving queries submitted by users for data relevant to the probability that a transaction with an entity will be successful" (column 6, lines 41-67 and column 7, lines 1-17) note the search is for a entity that has entered the reciprocal search which would lead to a high probability of successful transaction between the user and entity; "a data gathering component for storing relevant data about submitted queries" (column 7, line 6-17); and a meta-query component responsive to a meta-query for returning information regarding previously submitted queries" (column 6, lines 41-67 and column 7, lines 1-35). Using the text of claim 1, other claims rejected are considered to have similar element disclosed by the same prior art cited.

26. As to claims 2 and 19, Moore teaches a system further comprising: "a performance-prediction component that uses data comprising including the stored submitted query data in making estimations relevant to the likelihood of success of a transaction involving an entity will be successful" (column 7, lines 18-35). Using the text of claim 2, other claims rejected are considered to have similar element disclosed by the same prior art cited.

27. As to claim 6, Moore teaches a system further comprising: "the meta-query component allows a user to register to be notified at some future time of submitted queries that are received about that user" (column 9, lines 41-63).

28. As to claim 7, Moore teaches a system further comprising: the meta-query component allows a user to register to be notified whenever a specified number of queries about that user

have been submitted to the system (column 9, lines 41-63) the specified number of queries is one.

29. As to claim 8, Moore teaches a system further comprising: "the query component also comprises a discovery component that allows users to receive a list of entities that satisfy certain criteria. (column 7, lines 46-58 and column 9, lines 10-24).

30. As to claim 11, Moore teaches a system further comprising: "the performance prediction component determines statistical correlations between patterns of submitted queries (column 7, lines 18-25).

31. As to claim 25, Moore teaches a system further comprising: "collecting query-relevant data comprising at least one of time, date, location, and identity" (column 6, lines 41-63).

32. As to claim 26, Moore teaches a system further comprising: "filtering the enhanced performance prediction information to remove at least some of the collected query-relevant data" (column 10 lines 1-28) only estimated time returned therefore rest of data was filtered.

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

34. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

35. Claims 3, 4, 9, 10, 16, 17, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore US Patent No. 6,847,938.

36. As to claims 3, 4, 16, 17, 23, and 24, Moore teaches a system further comprising: "the meta-query component returns" info from queries (column 9, lines 25-40).

37. Moore does not specify that this is a "copy" or "edited copy "of the claim However, the recorded queries are essentially records being stored in a data base and it is known to return copies or edited copies of the claims in order to would have been obvious to one of ordinary skill in the art to provide a copy or edited copy as this would consist of simply displaying what is stored and in order to decide whether offer is acceptable applicant must see at least a portion of the query which would be provided by edited copy (column 9, lines 25-40) as is shown by claims.

38. As to claims 9 and 10, Moore does not teach "businesses," however, it would be obvious for "businesses" to be considered the users. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention as "businesses" would also find it useful to trade there recourses and or equipment. If the users are considered to be businesses then Moore discloses returning info on records matched to users over a period of time (time from when query entered until records returned (column 9, lines 10-24 and 41-63). Further the it would be

obvious to return records on queries not related to the business (or user) as that would merely be the records from the period not returned as related to the business and would be advantageous as the business would be able to see what the competition was up to.

39. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore as applied to claim 1 above, and further in view of Kirkpatrick Patent Application Publication US 2002/0059258.

40. As to claim 5, Moore does not detail "an indication of a number of queries that have been submitted to the system during a particular time period", however, Kirkpatrick describes a system where "an indication of a number of queries..." (page 4, paragraph [0037]).

41. . It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine Kirkpatrick with Moore because doing so allows the tracking of the number of queries entered or the number entered with a particular term

Conclusion

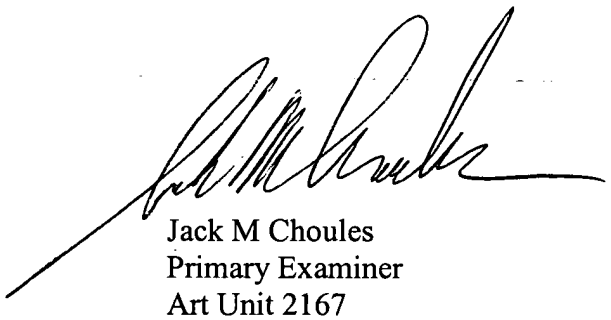
42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

43. Hedgcock et al. US 6,182,060 transaction records.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules
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JMC